

### **REMARKS**

Claims 18-22 and 27-46 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein. Claims 33-46 are added by this amendment. Claims 10-17 and 23-26 are canceled by this amendment.

If the amendments herein do not place the present application in condition for allowance, Applicant respectfully requests that the Examiner contact Applicant's representative to conduct an interview regarding the pending claims and the cited art.

### **REJECTION UNDER 35 U.S.C. § 102 AND § 103**

Claims 27 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mumme et al. (U.S. Pat. No. 5,364,402). Claims 27-29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ferrante et al. (U.S. Pat. No. 5,709,689). Claims 31 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mumme et al. (U.S. Pat. No. 5,364,402) in view of Masini (U.S. 5,897,889). These rejections are respectfully traversed.

Independent Claim 27 has been amended and is directed to selecting a first and second resection instrument and resecting a first portion and a second portion of a bone portion. The method is also directed to resecting a first portion a first amount and resecting a second portion a second amount that is generally equivalent to the first amount.

Mumme et al. is directed to a tibial spacer saw guide. In particular, the spacer saw guide allows for the resection of a greater bony defect on the medial or lateral side

of the tibia. See col. 5, lines 14-17. The saw guide of Mumme et al. defines slots 104, 106 that have different displacements to allow for the different amounts of material removal. See col. 4, lines 25-30. Further, Mumme et al. discloses an initial resection of the proximal tibia to resect the least involved side of the tibial plateau. See col. 4, lines 61-63. Only after the initial resection is a second resection performed to resect the greater bony defect. Mumme et al. specifically discloses making a second resection of a second amount that is not equivalent to a first amount. Therefore, not only does Mumme et al. not teach or fairly suggest each of the elements of Independent Claim 27, Mumme et al. actually teaches away from the method recited in Independent Claim 27. Mumme et al. teaches resecting a second amount that is greater than a first amount, thus, Mumme et al. can not teach resecting a second portion of the selected bone portion a second amount generally equivalent to the first amount of the first resection.

Ferrante et al. is directed to a multiple resection guide. Ferrante et al. disclose performing an anterior and then a distal resection on a femur and afterwards using a multiple resection guide that corresponds to an implant size. See col. 6, lines 40-58. The multiple resection guide allows different resections to be made on the femur, each with the multiple resection guide. Therefore, Ferrante et al. does not teach or fairly suggest resecting a second portion of the selected bone a second amount generally equivalent to the first amount. Although Ferrante et al. discloses making several resections, Ferrante et al. does not teach or fairly suggest making a first resection and a second resection of equivalent amounts. Further, Ferrante et al. does not teach or fairly suggest resecting a second “portion using [the] first resected portion” and a second resection instrument. Ferrante et al. disclose the use of the multiple resection guide to

make the resections, but not using a first resected portion. Therefore, Ferrante does not teach or fairly suggest each of the elements of Independent Claim 27.

For similar reasons, each of the claims that depend either directly or indirectly from Independent Claim 27, are also in condition for allowance.

Masini does not teach or fairly suggest a reaming guide or reaming, as recited in Dependent Claim 31. Masini is directed to an intermedullary rod 102 onto which outriggers can be positioned to guide an oscillating saw. See col. 2, lines 65 to col. 3, line. 1. Dependent Claim 32 is also not taught or fairly suggested by Mumme et al. and Masini. As discussed above Mumme et al. does not teach or fairly suggest each of the elements of Independent Claim 27 and Masini does not overcome the failings of Mumme et al.

#### **NEW CLAIMS**

New Independent Claim 33 is directed to subject matter that is within the scope of the elected claims. Further, Applicant submits that independent Claim 33 is patentable in light of the cited art. The cited art, either alone or in combination, does not teach or fairly suggest guiding a drill bit, reaming a first portion of a selected bone portion, and guiding a saw blade to resect the second portion of the bone portion relative to the reamed section. Therefore, Applicant submits that Independent Claim 33, and each of the claims that depend either directly or indirectly therefrom, are in condition for allowance.

Also, new claims 38-40 that depend directly or indirectly from Independent Claim 27 include patentable subject matter. The cited art, either alone or in combination, does

not teach or fairly suggest a reamer for reaming a selected portion of bone to make a resection thereof and forming a second resection of an equivalent amount. Also, the cited art does not teach or fairly suggest a first resection instrument that is different than a second resection instrument for performing resection of a first portion and a second portion, respectively.

New independent Claim 41 is also in condition for allowance in light of the cited art. Independent Claim 41 is directed to reaming a first portion, positioning a saw guide relative to the reamed section, and guiding a saw blade with the positioned saw guide to resect a second portion of the bone portion. The cited art does not teach or fairly suggest reaming a first portion and positioning a saw guide relative to the reamed section. The positioned saw guide is used to guide the saw blade to resect the second portion. Further, various claims that depend directly or indirectly from independent Claim 41 are also in condition for allowance. For example, dependent Claim 42 is directed to reaming and guiding the saw blade through a formed incision. Further, dependent Claim 43 is directed to interconnecting the saw guide with a bone portion via a bore. Claim 46 is directed to the second portion of the bone only being resected with the saw blade.

#### **ELECTION**

Applicant submits that each of the newly added claims 33-46 is within the scope of the election made, with traverse, on April 14, 2006. Applicant elected Group III, which included claims 18-22 and 27-32. Applicant submits that Claim 18 is directed to forming an incision, forming a reamed portion, and resecting a second portion that is guided

relative to the reamed portion. Claim 27 is directed to selecting a first and second resection instrument and resecting a first and second portion. New Claim 33 is of similar scope in that it is directed to forming an incision, guiding a drill bit, reaming a first portion, and guiding a saw blade to resect a second portion relative to a reamed section. Claim 41 is directed to reaming a first portion of a bone to form a reamed section and positioning a saw guide relative to the reamed section and resecting a second portion relative to the reamed section. Applicant submits that each of these claims are of similar scope and within the scope of the elected invention.

Unelected and canceled original claims 1-8 and 23-26 were drawn, broadly, to an apparatus. Unelected and canceled original claims 10-17 were drawn, broadly, to positioning a rod and a reamer guide. Applicant submits that newly added claims 33-46 may be generic to this subject matter, but are within the scope of the elected invention to which Claims 18-22 and 27-32 are drawn.

#### **ALLOWABLE SUBJECT MATTER**

Applicant thanks the Examiner for the allowance of 18-22.

## CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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